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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. 146

BRYAN W. NICKERSON, JR.,
Petitioner,

v.

THE BEARFOOT SOLE CO., INC.,
THE BEARFOOT AIRWAY CORP.,
Respondents.

RESPONDENTS' BRIEF OPPOSING PETITION FOR CERTIORARI.

EVERETT R. HAMILTON,
First National Tower,
Akron 8, Ohio,
Counsel for Respondents.

HAMILTON & COOK,
Of Counsel.

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STATEMENT.

(1) No conflict of lower Court decisions and no constitutional issue are involved in this case. There are no "special and important reasons" for review by this Cour as set forth in Supreme Court Rule 19. The only apparer reason presented by petitioner *pro se* for granting certiorari is that in deciding against him the Court of Appeals erred because it did not understand the "real truth" and "did not act with propriety"; and that failure to grant certiorari would be to "knowingly compromise judicial integrity" and endanger the whole patent system. If such a reason were to be held adequate for certiorari, all unsuccessful litigants would be encouraged to take their cases *pro se* to the Supreme Court on the ground that the Court below did not understand the true facts of the case.

"The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower

court decisions." (Address of Chief Justice Vinson before American Bar Association, Sept. 7, 1949.)

Seldom has the record and Patent Office history of a patent been more carefully reviewed and thoroughly analyzed by a Court in an effort to understand the true facts than was done in the exhaustive unanimous decision by the Sixth Circuit Court of Appeals in this case.

The petitioner, in filing this petition *pro se* and emphasizing his low income, is following a pattern similar to that which he used in the Patent Office to obtain his Reissue Patent No. 24,518, now held invalid by the Court of Appeals for the Sixth Circuit.

In the Patent Office, petitioner employed attorneys who obtained his original patent for an attachable white sidewall for automobile tires, but when respondent's sidewall appeared on the market shortly thereafter, petitioner filed application *pro se* for reissue, claiming that the original patent claims were the result of "negligent drafting" on the part of his attorneys. (App. p. 85a.)*

In this litigation, petitioner employed attorneys to represent him in the District Court and Court of Appeals, and when his Reissue Patent was held invalid he filed this petition *pro se*, stressing the fact that he is of low income and the father of four.

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* Refers to appendix of appellant in Court of Appeals.

STATUTES INVOLVED.

In citing Title 35 U. S. Code, Sections 251 and 114, petitioner has omitted Title 35 U. S. Code, Section 103, as follows:

> "§ 103. Conditions for patentability; non-obvious subject matter.
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

That this statute is involved is clear from the Court of Appeals decision (Dec. page 31),* as follows:

> "Rubber is not a completely unknown and mysterious substance. Children know it in numerous forms, from bouncing balls and elastic rubber bands to resilient bicycle and automobile tires. It is *obvious*** to anyone that if a flat sheet of resilient rubber is bent out of its molded shape, it will press against the bending force and fly back to its original flat form when the pressure is released. So, it is *obvious* to anyone that if resilient rubber is molded in a curved form, it will likewise press against anything that pushes it out of such curved form. It would be *obvious* to anyone skilled in the art that a resilient rubber side wall curved inwardly and having a lip inserted between the rim flange and adjacent portion of a tire would press against the tire and, if formed in the requisite shape, would engage the tire."

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* Refers to decision of Sixth Circuit Court of Appeals.

** Emphasis supplied in all quotations.

QUESTIONS PRESENTED.

Questions 1 and 3 present no questions of law. Question 1 asks, in effect, if it is proper for a Court of Appeals to decide a case contrary to "the truth" in the record as interpreted by the unsuccessful litigant. Question 3 asks if a Court can use words of a Patent Office Examiner, who was reversed by the Board of Appeals, to support the Court's conclusions in deciding against the petitioner.

Question 2 attempts to inject a question of law by implying that the Court of Appeals decision holds that the subject of a patent must be tested for operability to be patentable.

ARGUMENT.

Question 2.

Referring first to Question 2, petitioner himself says (Pet. page 8):

> "The District Court and Circuit Court found the structure operative. Operativeness is not an issue here"

What the Court of Appeals said was:

> "Appellants claim that Nickerson's side wall would be inoperable with any tires, high pressure or low pressure, for the same reason that it would not be operable with low pressure tires having a pronounced lug. The evidence supporting this contention is persuasive; but *we do not decide this case on the ground that Nickerson's patent is inoperable*. In this regard, we leave the presumption of operability untouched, and do not interfere with the trial court's findings on this phase of the case."

Actually, petitioner is posing Question 2 for the obvious purpose of enlisting the sympathy of the Supreme Court for an individual who is unable financially to spend

huge sum of money to test and develop his invention. By petitioner's own admission, this situation is not an issue here.

Petitioner says the Court of Appeals decision "infers" that an inventor who does not actually produce and test his invention for operativeness does not have a valid patent, and that if a Court invalidates a patent because it is an inoperative paper patent, then the U. S. government has encouraged the inventor to disclose his invention "under false pretenses."

The Patent Office granted petitioner his patent without any requirement of petitioner to test his invention for operability, and the Court of Appeals did not question the propriety of such grant. It was only after petitioner sued respondent that the issue of inoperability was raised by respondent. Petitioner was able to hire counsel and a well-known patent expert to try the case, but made no attempt at the trial to demonstrate that respondent's claim of inoperability was invalid. The Court of Appeals said (Dec. pp. 30, 31):

> "Nearly two years elapsed after appellants' answer was filed before trial, but appellee, confronted with the claim that his side wall was inoperable, never tried to show by an actual side wall made according to his patent, that it was operable. Dr. Hoover, appellee's expert witness, was asked whether he had ever made a Nickerson side wall. His reply was 'No.' To the question whether he had tried to make a Nickerson side wall, his answer was: 'No, not particularly. We considered having one made but I'll say we got started a little late.' In view of the defense that a side wall made in accordance with Nickerson's patent was inoperable, and in view of the fact that the only time appellee ever tried to make a side wall in accordance with his patent, it was a failure and he could not make

a true side wall—and neither he nor his expert witness ever tried again to make a side wall in accordance with his patent—the *presumption that the patent is operable disappears.*"

Apparently, petitioner would rewrite the Patent Laws to provide that once a patent is granted by the Patent Office, no Court has the right to question operability of the invention, or to hold a patent valid for inoperability even if so proven, contrary to the established case law.

Walker on Patents, Deller's Ed., page 313, states the rule as follows:

"Utility is absent from all processes and devices which cannot be used to perform their specific functions, and patents for such subjects are therefore void." (Citing authorities.)

And on page 314:

"In *Bliss v. Brooklyn*, 10 Blatchf. 521, 522, Fed. Case No. 1546 (1873), the patent covered a certain hose-coupling. The contrivance was worthless, because it was proved *on trial* to be inoperative."

According to the syllabus in *H. Brinton Co. v. Mishcon*, 93 F. 2d 445 (C. A. 2—1937):

"A device to be patentable must be useful, and to be useful it must work. (35 U. S. C. A. §31)."

Question 1.

Petitioner's discussion of facts re Question 1 admits that an erroneous decision *per se* does not warrant review by the Supreme Court, and then argues for about 15 pages that the decision of the Court of Appeals is erroneous because it is wanting in accuracy and truth. What petitioner construes as the truth is the opposite of the Court's findings in its decision.

It would seem unnecessary to burden this Court with a detailed refutation of petitioner's claimed errors allegedly committed by the Court of Appeals. The Court's decision fully answers all of these allegations. For example, petitioner says (Pet. p. 7) that the invention was accomplished by departing substantially from the teachings of the prior art. The Court of Appeals said (Dec. p. 32):

> "What Nickerson did was to give his side wall an inward bend which an inflated tire would push against. This was old in the art. Barnes had done the same thing before Nickerson; and Bearfoot, whether it followed the Barnes' patent or not, did the same thing before Nickerson."

Petitioner says (Pet. p. 8) that:

> "The initial pre-distorted, cross-sectional shape of the side wall is in fact the invention."

After extensive review of the patent file wrapper, the Court of Appeals held (Dec. pp. 28, 29):

> "All of the foregoing means, in the simplest terms, that a rubber side wall elastic and resilient in itself, and made with an inward bend, will hug the tire when the latter is inflated, since its own resistance holds it against an inflated tire." * * *
>
> "At no time during the many different rulings of the Examiner and the Board of Appeals, reciting

reasons for granting or rejecting the numerous claims of appellee, was there any mention of anything from which it could be inferred that they considered any of the phraseology as to the shape of the side wall, being axially inwardly of the distorted operational position, or the side wall being biased outwardly, or curved inwardly, as elements partaking of patentable invention.

"The original patent and the reissue must have been and were, granted because of entirely different features than anything defined in the foregoing phraseology. For the claims of a patent must be interpreted with respect to cancelled or rejected claims, and an allowed claim may not be read to cover what has been eliminated from the patent. *Miller v. Zaharias*, 72 F. Supp. 29; aff. 168 F. 2d 1; cert. den. 335 U. S. 823."

Petitioner's Statement of Facts is nothing more than a repetitious argument countering alleged errors in the Court of Appeals' decision by self-serving statements of "The truth" as petitioner sees it. The Court of Appeals went over all this ground with a fine-toothed comb, and concluded not only that the patent was invalid for want of invention, but even if valid, it was not infringed by respondent (Dec. p. 39).

Of the twelve alleged errors, possibly Error 2 needs clarification because of the petitioner's complete misunderstanding of Patent Law. According to petitioner Error 2 was the Court's contention or inference that activity by respondents prior to the issuance of petitioner's patent somehow invalidates the patent.

What the Court said was (Dec. p. 12):

"On October 1, 1956, almost two years after Bearfoot began manufacturing the side walls in question, Nickerson filed his application for a reissue patent."

Obviously, the Court had in mind the Reissue Statute, Title 35 U. S. Code, Section 252, which reads in part:

> "No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent."

Petitioner's reference to interference proceedings in the Patent Office is wholly irrelevant, since neither his reissue nor his original patent were ever involved in any interference proceedings.

Question 3.

Apparently, petitioner is complaining because the Court of Appeals agreed with certain statements made by the Examiner in the Patent Office, even though he was reversed by the Patent Office Board of Appeals. This is tantamount to a contention that the Supreme Court in this case could not agree with the decision of the District Court because it was reversed by the Court of Appeals, which is precisely what the petitioner is asking the Supreme Court to do.

Question 3 is specious on its face.

Petitioner implies that the Board of Appeals reversed the Examiner and allowed the reissue application. Actually, the Board of Appeals first affirmed the Examiner and on reconsideration reversed his rejection, but since it reversed on new grounds, it remanded the case to the Examiner who subsequently allowed the application with a single new claim not involved in the original appeal.

Petitioner's so-called "Reasons For Granting The Writ of Certiorari" are nothing more than an argumentative criticism of the Court of Appeals because its decision was, in the petitioner's opinion, "an extremely unbelievable, erroneous decision."

The inconsistency of petitioner's argument is readily apparent from the following two statements from his petition:

> "It took almost a year to hand down the decision which numbered thirty-nine pages, and the Circuit Court commented extensively on the file wrapper, etc. It would appear indeed that the Circuit Court had done a very thorough job." (p. 22)
>
> "The Circuit Court, relying on the arguments of counsel, without self-determination from the record, reversed the Trial Court." (p. 23)

To accuse the Court of Appeals of applying a practice which provides "fertile ground for corruption and the whole patent system is in danger," and to imply that allowing the Court's decision to stand would be "to knowingly compromise judicial integrity," are very serious charges even for a disgruntled individual who sought to litigate his patent in the Federal Courts.

Respondents are small corporations who, after taking a license and paying royalties in good faith under the Barnes patents, were sued without prior notice for infringement of petitioner's paper patent, and thus subjected to the expense and harassment of litigation jeopardizing the continuance of their business. Petitioner has had his full day in Court, and, after an extensive review of the merits of the case, the Court of Appeals below has ruled against him *on the facts*.

CONCLUSION.

The petition does not present any questions requiring resolution by this Court, and should be denied.

Respectfully submitted,

EVERETT R. HAMILTON,
First National Tower,
Akron 8, Ohio,
Counsel for Respondents.